



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,413	10/30/2000	Joseph A. Swift	D/A0430; 690-009492-US	5640

7590

03/26/2003

Thomas L. Tully
Perman & Green, LLP
425 Post Road
Fairfield, CT 06430

EXAMINER

GUARRIELLO, JOHN J

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/26/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698413

Applicant(s)

Swift et al.

Examiner

John Guarriello

Group Art Unit

1791

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/22/2003
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) 7-12 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). #2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1771

DETAILED ACTION

15. The Examiner acknowledges the affirmation of the Restriction, paper # 5 of 1/22/2003, regarding Group I, claims 1-6. Group II, claims 7-12, directed to the method of making the article of Group I is withdrawn.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restriction

17. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to a continuous intermediate belt, classified in class 442, subclass 68.
- II. Claims 7-12, drawn to process of making a continuous intermediate belt with coating steps, classified in class 427, subclass 214.

18. The inventions are distinct, each from the other because:

Art Unit: 1771

19. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as electrostatic spraying, sonic spraying, or blade coating. The outer layer can be coated on the primer coated substrate in any suitable known manner, page 10, lines 19-25 of the instant specification. Applicant's arguments regarding the traversal of the Restriction requirement have been considered, the Restriction requirement is remade.

Claim Rejections - 35 USC § 103

20. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlueter, Jr. et al. 5,922,440 in view of Chang et al. 5,991,590.

Schlueter describes an intermediate toner-transfer belt having a polyimide film support substrate (corresponding to the claimed fibrous fabric

Art Unit: 1771

layer), an adhesive binder layer (corresponding to the claimed elastomeric layer which anchors to the fibrous fabric), a polymer layer which can be silicone rubber (corresponds to the thin layer of silicone) which adheres to the outer layer and the substrate, (column 10, lines 5-9), and, an outer release layer (corresponding to the claimed thin outer layer), (column 9, lines 60-67; column 10, lines 1-9). Schlueter differs from the claimed invention because it is silent about the fibrous fabric layer substrate and the outer release layer of the release agent material.

Chang describes the fibrous fabric materials for transfer belts as woven materials, among others, (column 3, lines 23-67). Chang describes silicone rubbers, polyvinyl fluoride, and fluorocarbon elastomers, (column 3, lines 47-57).

Chambers which is directed to toner transfer members, describes the release layer agent material which corresponds to the claimed thin outer layer, (column 4, lines 26-55).

Art Unit: 1771

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the fibrous fabric layer of Chang for the polyimide film support of Schluetter motivated with the expectation the intermediate belt substrate would exhibit improved mechanical strength and good heat insulating properties, (column 3, lines 47-57).

Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made employ the release agent material of Chambers, which corresponds to the claimed thin outer layer, for the outer release layer of Schlueter motivated with the expectation that improved toner particle release be evidenced, (column 5, lines 55-58).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The

Art Unit: 1771

fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



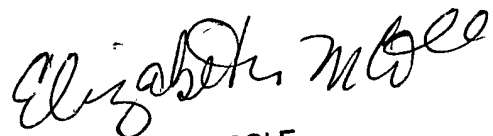
John J. Guarriello:gj

Patent Examiner

March 12, 2003

March 18, 2003

March 21, 2003


ELIZABETH M. COLE
PRIMARY EXAMINER